

### **REMARKS**

By this Amendment, Applicants add new claim 16. Accordingly, claims 1, 8, 15, and 16 are now pending in this application.

In the Final Office Action,<sup>1</sup> the Examiner rejected claims 1, 8, and 15 under 35 U.S.C. § 102(e) as being anticipated by Beaton et al. (U.S. Patent No. 6,442,263).

Applicants respectfully traverse the rejection for at least the following reasons.

To properly anticipate Applicants' claimed invention, the Examiner must demonstrate the presence of each and every element of the claim in issue, either expressly described or under principles of inherency, in a single prior art reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." See MPEP § 2131, *quoting Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Finally, "[t]he elements must be arranged as required by the claim." MPEP § 2131.

Claim 1 recites a combination including, among other things, a "display mode setting means for setting either a first display mode for displaying only the received message received by said message receiving means or a second display mode for displaying only the user identification information stored in the phone book" (emphasis added).

In the Final Office Action, the Examiner "interprets the claimed 'display mode setting means' as the program that sets either a first display mode or a second display mode." See Final Office Action, page 6. Furthermore, in the Final Office Action, in

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<sup>1</sup> The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

applying Beaton, the Examiner cites steps 1635 and 1630 of Figure 16 and contends that these steps constitute the claimed “first display mode” and “second display mode.” See page 2. Applicants respectfully disagree with the Examiner’s interpretation.

During examination, the words of a claim should be interpreted consistent with the “broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant’s specification.” See MPEP § 2111. In rejecting claim 8, the Examiner has not construed the claimed “first display mode” and the “second display mode,” which are set by the “display mode setting means,” in a manner that is consistent with Applicants’ specification. Nor has the Examiner construed these claim recitations in a manner that is consistent with how the words would be understood by one of ordinary skill in the art.

For example, Applicant’s specification at page 16, lines 5-13 discloses determining a current set mode. Furthermore, the meaning of the term “mode,” as understood by one of ordinary skill in the art, is “the state or setting of a program or device. ... The term mode implies a choice -- that you can change the setting and put the system in a different mode.” See Webopedia Computer Dictionary definition of “mode,” available: <http://www.webpoedia.com>.

Turning now to Beaton and, in particular, to Figure 16, Beaton teaches that a decision is made in step 1625 whether an entry is in a table. If the entry is in the table, then the program displays the icon from the table (step 1630). If the entry is not in the table, then the program displays the transmitted icon (step 1635). A program that

evaluates a condition, such as the one taught by Beaton, does not constitute Applicant's "display mode setting means" that sets either a "first display mode" or a "second display mode." Rather, Beaton evaluates a condition and determines how to proceed based on the outcome of the evaluation, but does not teach setting Applicants' claimed modes. Accordingly, Beaton does not disclose at least a "display mode setting means for setting either a first display mode for displaying only the received message received by said message receiving means or a second display mode for displaying only the user identification information stored in the phone book," as recited in claim 1 (emphasis added).

Furthermore, according to Beaton, a CLID (calling line identification) "displays the caller's name and telephone number on the receiver's device." See col. 1, lines 32-35. When a call is received, and there is a match between the telephone number included in the CLID and an entry in table 600, "program 520 displays the CLID information with the icon associated with the transmitted telephone number from table 600." See col. 10, lines 41-47. When there is not a match, "program 520 displays the CLID information with the transmitted icon." See col. 10, lines 48-50. Thus, when either event occurs, the CLID information is always displayed with a stored icon or a transmitted icon. By contrast, claim 1 requires that the claimed "first display mode" displays "only the received message received by said message receiving means" and the claimed "second display mode" displays "only the user identification information stored in the phone book." Since Beaton displays the CLID information received from the caller with an icon, it does not teach at least these elements of claim 1. Therefore, claim 1 is not anticipated by Beaton for at least this additional reason.

For at least the above reasons, the Examiner should withdraw the rejection of claim 1 under 35 U.S.C. § 102(e).

Claims 8 and 15, while of a different scope from claim 1 and each other, include recitations similar to those discussed above with respect to claim 1. Accordingly, Beaton also fails to teach all of the elements required by claims 8 and 15 for at least the reasons given above. Therefore, the Examiner should also withdraw the rejection of claims 8 and 15 under 35 U.S.C. § 102(e).

New claim 16, while of a different scope from claims 1, 8, and 15, includes similar recitations as those discussed above. Accordingly, the Examiner should allow new claim 16 over Beaton for at least the reasons discussed above.

#### **CONCLUSION**

In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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